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IN THE

Supreme Court of the United States

October Term, 1969.

No. 943.

CONTINENTAL CAN COMPANY, INC.,
Petitioner,

v.

CROWN CORK & SEAL COMPANY, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

H. Francis DeLone,
Harvey Bartle, III,
1600 Three Penn Center,
Philadelphia, Pa. 19102,

Virgil E. Woodcock,
1831 The Fidelity Building,
Philadelphia, Pa. 19109,
Attorneys for Respondent.

Of Counsel:
Dechert Price & Rhoads,
Woodcock, Phelan & Washburn.

International, 711 So. 50th St., Phila., Pa. 19143—Tel. SA 7-8711 Area Code 215

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QUESTION PRESENTED.

Did the Court of Appeals correctly hold that the prior art made obvious to one having ordinary skill in the art the invention of patent 2,654,914?

STATEMENT OF THE CASE.

Continental Can Company's Maier patent 2,654,914, the validity of which was in issue in this case, concerns a method for lining metal bottle caps of the type commonly used on beer and soft drink bottles with a synthetic plastic material known as plastisol. It calls for an unlined cap to move under a heated nozzle which deposits into the cap a "button" of hot liquid plastisol. After the deposit of the plastisol, the cap is conveyed onto a heated surface where a heated plunger enters the open side of the cap and compresses and shapes the button to form a liner within the cap. The heat from the plunger and from the surface (or platen) below the cap brings the plastisol button, in two or three seconds, to temperatures ranging from 275°-375°F., which partially cure the plastisol. Curing and hardening of the molded liner is then completed in an oven.

The "inventor" of the patent in suit acknowledged that the idea of using a heated plunger, a heated platen and a curing oven to mold bottle cap liners came from the prior art Evans & Schneider patent 2,688,776 (A-3; 105a; 108a; see 183a-186a).[1] In addition, plastisol was not new as a lining for bottle caps. It had been described in the prior art Foye South African patent 2556/47 (A-3; 133a-168a) which employed a heated nozzle to deposit the plastisol into a cap. This Foye patent was expressly referred to in the patent in suit (130a). As Petitioner admitted, when prosecuting its patent before the Patent Office, the Foye patent ". . . describes the characteristic properties of the resin

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1. References with the prefixes "A" and "B" are to the appendices A and B respectively of the Petition for a Writ of Certiorari. References with the suffix "a" are to the appendix in the Court of Appeals.

paste [plastisol[2]] which makes it peculiarly suitable for the present process." (Defendant's Exhibit 77 at page 36).

Prior art literature concerning plastisol had also disclosed that plastisol in a fluid state could be converted, in a matter of seconds, into a solid substance by heating it to the temperatures employed in the patent in suit (A-5; 215a, 233a).

The District Court held the patent to be valid and infringed but the Court of Appeals reversed because the teaching of the patent was obvious in light of the prior art.

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2. The lining material was referred to at the trial as "paste resin" or plastisol, and the terms were treated as synonomous (80a-81a). The patent in suit used the terminology "paste resin."

ARGUMENT.

This case raises no important or novel questions such as is contemplated by Supreme Court Rule 19; it involves only whether the "obviousness" test prescribed by Section 103 of the Patent Act of 1952, 35 U. S. C. § 103, has been properly applied to the particular facts presented.

This Court has considered Section 103 of the Patent Act on several recent occasions. *Graham v. John Deere Co.*, 383 U. S. 1 (1966); *United States v. Adams*, 383 U. S. 39 (1966); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 38 LW 4024 (U. S. Dec. 8, 1969). These recent decisions establish that to resolve the issue of obviousness "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Graham v. John Deere Co.*, 383 U. S. 1, 17 (1966); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 38 LW 4024, 4025 (U. S. Dec. 8, 1969).

Petitioner suggests that the Court of Appeals applied a "hindsight" test in resolving the question of obviousness, but it neither explains what it means by a "hindsight" test nor undertakes to demonstrate that the Court of Appeals utilized such a test. Examination of the Court of Appeals' opinion discloses, however, that the Court of Appeals carefully followed the mandate of this Court's recent opinions. It reviewed the state of the art "at the time the invention was made", 35 U. S. C. § 103. This review disclosed, as the trial court had found, that "practically every major step of the process is to be found somewhere in the prior art" (B-4). The mechanical structures employed in the patent in suit were concededly found in prior patents, and the characteristics of plastisol which made it suitable for

use in these structures were likewise disclosed in prior patents and literature (A-3, A-4–A-6; 133a-168a, 215a, 233a). Accordingly, the Court of Appeals quite properly concluded that the method of the patent in suit was obvious to "a person ordinarily skilled in the art." (A-7). The Court of Appeals, unlike the District Court, followed the teaching of *Great A&P Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 153 (1950), recently restated in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 38 LW 4024, 4025 (U. S. Dec. 8, 1969), in holding that the secondary considerations of commercial success, long felt but unsolved need, and failure of others cannot be used to sustain a patent, the disclosures of which are obvious in light of the prior art (A-3–A-4).

Petitioner also seems to suggest that there is some conflict between the decision of the Court of Appeals below and decisions in other circuits, with reference to the application of the test of obviousness under Section 103 of the Patent Act. However, the Petitioner nowhere demonstrates any such conflict. Even if there were some basis for the claim of divergence among the circuits, there can no longer be a need for the grant of certiorari to resolve it. This Court's December 8, 1969 decision in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 38 LW 4024, 4025 (U. S. Dec. 8, 1969) settles, once and for all, how the courts of appeals are to apply the "obvious-nonobvious standard" to patents which, like the patent in suit, merely combine elements disclosed in the prior art.

CONCLUSION.

For these reasons, a Writ of Certiorari to review the judgment and opinion of the Court of Appeals for the Third Circuit should be denied.

Respectfully submitted,

H. Francis DeLone,
Virgil E. Woodcock,
Harvey Bartle, III,
Attorneys for Respondent.